

PATENT

APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF PATENT APPEALS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of)	Examiner: Christopher L. GILLIGAN
)	
Richard C. JOHNSON)	Art Unit: 3626
)	
For: eDROPSHIP: METHODS AND)	Confirmation No.: 7640
SYSTEMS FOR ANONYMOUS)	
eCOMMERCE SHIPMENT)	Customer No.: 53156
)	
Serial No.: 09/490,783)	
)	
Filed: January 24, 2000)	
)	<u>APPEAL BRIEF</u>
Atty. Docket No.: ORCL5628)	
)	
)	

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief in support of the Notice of Appeal filed August 20, 2007. The fees due under 37 C.F.R. §41.20(b)(2) in the amount of \$500.00 (Fee Code 1402) are provided herewith.

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A. Real Party in Interest

The real party in interest is Oracle International Corporation; a corporation that is organized under the laws of the state of California and that has its principal place of business at 500 Oracle Parkway, Redwood Shores CA 94065. The real party in interest, Oracle International Corporation, obtained the entire right, title and interest in and to the present patent application by virtue of an assignment from the original assignee, Oracle Corporation, executed on February 18, 2003, and recorded in the United States Patent and Trademark Office on March 4, 2003, at reel/frame 013808/0035. The original assignee obtained the entire right, title and interest in and to the present application by virtue of an assignment from the inventors to Oracle Corporation executed on January 14, 2000, and recorded in the United States Patent and Trademark Office on January 24, 2000, at reel/frame 010530/0009.

B. Related Appeals and Interferences

None.

C. Status of Claims

Claims 1-28 were originally presented for examination. The current status of the claims is as follows: claims 1-4, 7-10 and 13-16 are pending and claims 5-6, 11-12, and 17-28 are canceled. The rejection of each of the claims 1-4, 7-10 and 13-16 is appealed herewith.

D. Status of Amendments

This application was filed on January 24, 2000. A first Office Action was mailed July 9, 2002, and an Amendment was filed November 6, 2002. A second Office Action was mailed January 16, 2003, and an Amendment was filed April 16, 2003. A final Office Action was mailed June 10, 2003, and a Notice of Appeal was filed November 10, 2003, followed by a Request for Continued Examination and Amendment Under §1.116 were filed February 9, 2004. A Supplemental Amendment was filed on May 10, 2004, in response to a Notice of Non-Compliant Amendment mailed May 2, 2004. An Office Action was mailed August 26, 2004, and a Response was filed November 24, 2004. A final Office Action was mailed on February 8, 2005, to which a Response was filed May 9, 2005. An Advisory Action was mailed May 19, 2005, and another Request for Continued Examination was filed June 8, 2005, followed by a subsequent Amendment filed July 8, 2005. Another Advisory Action was mailed August 5, 2005, and an Examiner-Initiated Interview took place on August 19, 2005, followed by a Notice of Abandonment mailed August 25, 2005. A Petition for Revival of an Application for Patent Abandoned Unintentionally and an Amendment Under §1.116 were filed October 6, 2005. A Decision dismissing the Petition and another Advisory Action were mailed December 15, 2005. A Renewed Petition and Request for Withdrawal of Notice of Abandonment was filed December 23, 2005, with a copy of the RCE previously filed on June 8, 2005. A second Decision dismissing the Petition was mailed January 30, 2006. Another Renewed Petition was filed February 6, 2006, together with copies and confirmations of previous filings, followed by a Decision granting the Petition which was finally mailed on February 24, 2006. An Office Action was mailed April 19, 2006, and a Response was filed July 19, 2006. An Office Action was mailed October 6, 2006, and a Response was filed

November 18, 2007. A final Office Action was mailed April 6, 2007, and a Response was filed June 26, 2007. A telephone conference with the Examiner took place on June 26, 2007, and another Advisory Action was mailed July 12, 2007. A Notice of Appeal and Extension of Time were filed August 20, 2007.

E. Summary of the Claimed Subject Matter

1. Independent Claim 1

According to a first embodiment, the present invention is a method for a trusted entity such as a bank (see 20 in Fig. 2 and page 9, line 24 to page 10, line 7) to enable anonymous shipment (see S21 in Fig. 2 and page 10, lines 10-21) by a shipper (see page 9, lines 15-16) of a package (see page 9, lines 17-23) containing goods purchased by a customer (see S21 in Fig. 2, page 9, lines 5-9 and page 10, lines 10-11) from a vendor (see page 9, lines 3-4) for delivery to an address (see page 9, lines 10-14) unknown to the vendor. As claimed, the customer maintains an account at the bank, and the bank stores an address associated with the customer's account. The claimed method includes steps of the bank receiving an electronic draft (see page 11, lines 6-10) from the customer for the purchase of the goods along with a request for a package code (see page 11, lines 12-23) for the package. As claimed, the bank may authenticate the customer (see S32 in Fig. 3 and page 17, lines 11-18) and may guarantee payment or honor the draft (see S35 in Fig. 3 and page 17, line 23 to page 18, line 2) to the vendor on the draft only if the customer is authenticated and bank-imposed restrictions are met (e.g., sufficient account balances or credit) (see page 18, lines 2-3). As claimed, if the customer is authenticated (see S32 to S34 in Fig. 3) and bank-imposed restrictions are met, the bank generates the requested package code, the package code being devoid of delivery address information. A discussion of package codes being devoid of delivery addresses is present at page 12, lines 1-5. Independent claim 1 then calls for the bank to send the generated package code (but does not send any delivery address) to the vendor (see S24 in Fig. 2, S37 in Fig. 3, page 11, lines 10-23 and page 12, lines 3-5). Claim 1 then calls for the bank to generate a shipping identifier for the package

that is associated with the generated package code and retrieving the stored address associated with the customer's account **(see S25 in Fig. 2 and page 12, lines 10-19)**. The bank is then claimed to send the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper **(see S25 in Fig. 2, S38 in Fig. 3, page 12, lines 10-19 and page 18, lines 4-11)**. The shipper, in this manner, after picking up the package for shipment from the vendor, can associate the package code sent to the vendor with the shipping identifier **(see page 14, lines 1-8)**. The shipper may then identify the associated address as the delivery address of the package, and may then ship the package directly from the vendor to the delivery address without divulging any delivery address for the package to the vendor, as claimed **(see S26 and S27 in Fig. 2 and page 12, line 23 to page 13, line 5)**.

2. Dependent Claim 2

The package code recited in claim 1 may include, for example, a code number and/or machine-readable indicia expressing the code number **(see page 11, lines 13-23)**:

Preferably, the package code sent to the vendor includes a code number and machine-readable indicia expressing the code number. The code number may be an entirely numerical code number or may include other symbols and/or letters. According to an embodiment of the present invention, the machine-readable indicia includes a barcode. Other machine-readable indicia may be used within the context of the present invention.

3. Dependent Claim 3

Dependent claim 3 calls for the received request to include a request for authentication and/or an electronic draft for payment of the purchased goods and/or a shipping charge **(see S22 in Fig. 2, S32 in Fig. 3 and page 17, lines 11-14)**. Shipping charges are disclosed throughout the specification.

4. Dependent Claim 4

Dependent claim 4 calls for the receiving and sending steps to be performed over a computer network (**see page 11, lines 12-13 and page 17, lines 15-16**). The network may include, for example, leased lines, a private network, a virtual private network and/or the Internet (**see 22 in Fig. 2 and page 4, lines 3-5**).

5. Dependent Claim 5

Dependent Claim 5 is canceled.

6. Dependent Claim 6

Dependent Claim 6 is canceled

7. Independent Claim 7

Independent claim 7 is written from the point of view of the shipper and is a method for a shipper to process a package identified by a package code devoid of delivery address information, the package containing goods purchased by a customer from a vendor for shipment to an address unknown to the vendor. Like terms are used in this claim as are used in claim 1. The definition of these terms and support thereof in the originally filed specification may be found in the summary section of claim 1. The method of independent claim 7 may include steps of the shipper receiving a request to pick up a package from the vendor, the package having a machine-readable package code affixed thereto but no delivery address (**see page 5, lines 1-6**). Claim 7 then calls for the shipper to receive a shipping identifier and a delivery address associated with the shipping identifier from a bank at which the customer having purchased the goods contained in the package maintains an account (**see S25 in Fig. 2 and page 12, lines 10-19**). As claimed, the delivery address sent by the bank to the shipper may be associated with the

customer's account at the bank (see S24 in Fig. 2). The delivery address may be retrieved (see S34 in Fig. 3 and page 17, lines 20-23). The package may be delivered to another address, such as a "care of" address (see page 14, lines 9-16).

Thereafter, as claimed, the shipper may pick up the package from the vendor (see S26 in Fig. 2 and page 12, line 23 to page 13, line 1). The shipper may then read the package code affixed to the package (see S26 in Fig. 2 and page 12, line 23 to page 13, line 3). The shipper, as claimed, may then match the package code with the received shipping identifier (see S26 in Fig. 2). The shipper may then, as claimed, deliver the package from the vendor directly to the delivery address associated with the shipping identifier (see S28 in Fig. 2 and page 13, lines 5-7).

8. Dependent Claim 8

Dependent claim 8 recites steps of printing a shipping label on which the delivery address is visible and affixing the shipping label on the package (see S26 in Fig. 2 and page 13, lines 2-3).

9. Dependent Claim 9

Claim 9 recites that the package code includes a code number and/or machine-readable indicia expressing the code number (see page 11, lines 13-23).

10. Dependent Claim 10

The receiving step, in claim 10, is recited to be performed over a computer network (see 22 in Fig. 2, page 11, lines 12-13 and page 17, lines 15-16).

11. Dependent Claim 11

Dependent Claim 11 is canceled.

12. Dependent Claim 12

Dependent Claim 12 is canceled.

13. Independent Claim 13

Independent claim 13 is written from the point of view of the vendor. Claim 13 recites a method for a vendor to cause a package of goods purchased by a customer to be delivered to a delivery address that is unknown to the vendor. Like terms are used in this claim as are used in claims 1 and 7. The definition of these terms and support thereof in the originally filed specification may be found in the summary section of claim 1. The method of claim 13 includes steps of the vendor sending a request for a package code to a bank at which the customer maintains an account and an electronic draft for payment of the goods on behalf of the customer (**see S22 in Fig. 2, page 6, lines 9-10 and page 10, lines 11-21**). As recited in claim 13, the vendor may receive payment on the draft and the package code from the bank only if the customer is authenticated by the bank and bank-imposed constraints are satisfied (**see S35 in Fig. 3**) (Honor Draft) (**see S35 in Fig. 3**) (Assign Package Code to Item Purchased by Customer), and (Send Package Code to Vendor) (**see S37 in Fig. 3**). The package, as recited in claim 13, is devoid of (e.g., does not include any) delivery address information (**see page 12, lines 1-5**). Continuing, claim 13 calls for the vendor to prepare the package for shipment by the shipper such that the prepared package bears no delivery address information thereon and affixes the received package code to the prepared package (**see page 12, lines 1-8**), which state:

According to an embodiment of the present invention, the package code is entirely devoid of any package delivery information. Alternatively, the package code includes the delivery address, but in a form that is unreadable by the vendor. In any event, the vendor is not given access to the package delivery address, and thus cannot misuse the information or include such information in any later (even legitimate) marketing or sales efforts. Having received the package code from the bank 20, the vendor affixes or somehow otherwise imprints the package code on the package to be shipped. According to one embodiment of the present invention, the vendor affixes an adhesive label onto the package, the adhesive label bearing the package code thereon.

As claimed, the vendor may then surrender the package to a shipper to enable the shipper to match the package code with a shipping identifier and the delivery address that were previously received by the shipper from the bank, to generate a shipping label specifying the delivery address, to affix the shipping label to the package and to ship the package directly from the vendor to the delivery address without divulging any delivery address to the vendor **(see S26-S28 in Fig. 2 and page 12, line 23 to page 13, line 7).**

14. Dependent Claim 14

Dependent claim 14 recites that the package code may include a code number and/or machine-readable indicia expressing the code number **(see page 11, line 13).**

15. Dependent Claim 15

Claim 15 calls for the request to include a request for authentication and/or an electronic draft for payment of the purchased goods and/or a shipping charge **(see S22 in Fig. 2, S32 in Fig. 3 and page 17, lines 11-18).**

16. Dependent Claim 16

As recited in claim 16, the receiving and sending steps may be performed over a computer network **(see 22 in Fig. 2, page 11, lines 12-13 and page 17, lines 15-16).** The network may include, for example, leased lines, a private network, a virtual private network and/or the Internet **(see page 4, lines 3-5).**

17. Dependent Claim 17

Dependent Claim 17 is canceled.

18. Independent Claim 18

Independent Claim 18 is canceled.

19. Dependent Claim 19

Dependent Claim 19 is canceled

20. Dependent Claim 20

Dependent Claim 20 is canceled.

21. Dependent Claim 21

Dependent Claim 21 is canceled.

22. Dependent Claim 22

Dependent Claim 22 is canceled.

23. Dependent Claim 23

Dependent Claim 23 is canceled.

24. Dependent Claim 24

Dependent Claim 24 is canceled.

25. Dependent Claim 25

Dependent Claim 25 is canceled.

26. Dependent Claim 26

Dependent Claim 26 is canceled.

27. Dependent Claim 27

Dependent Claim 27 is canceled.

28. Dependent Claim 28

Dependent Claim 28 is canceled.

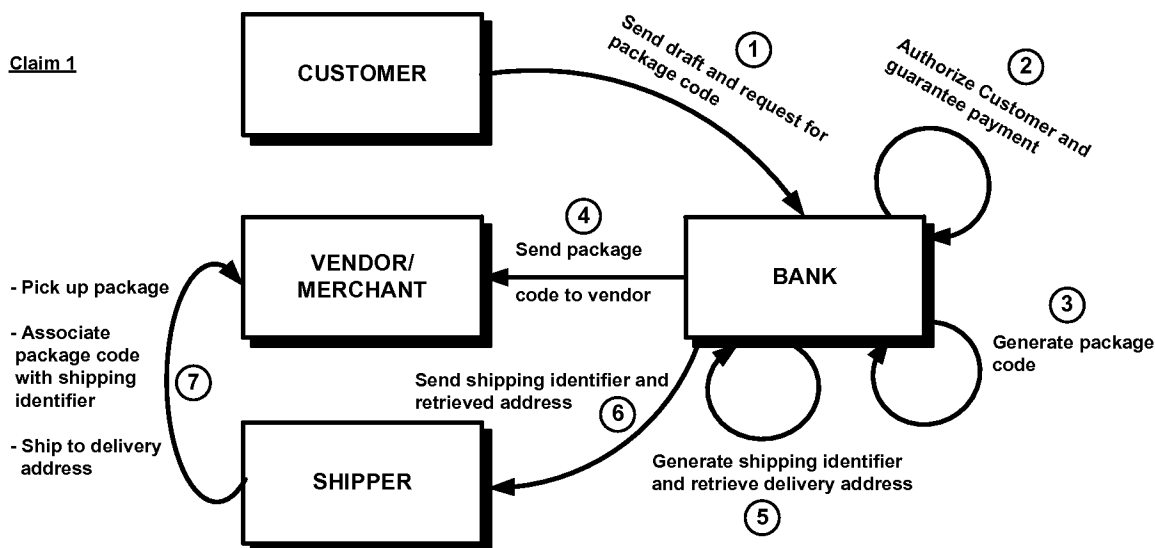
F. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1-4, 7-10 and 13-16 are patentable under 35 U.S.C. §103(a) over Shub et al. (U.S. Patent No. 6,807,530) in view of Kadaba (U.S. Patent No. 6,539,360).

G. Arguments

Independent Claim 1

Here is a graphical representation of the recited steps of claim 1:



Note, in particular, steps 1, 5 and 6, which correspond to the recited steps of claim 1:

the method comprising the steps of:

the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;

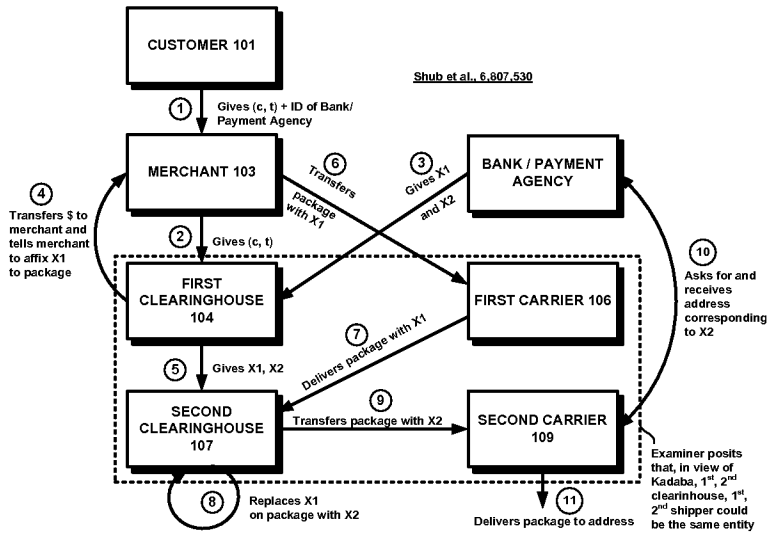
...

the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and

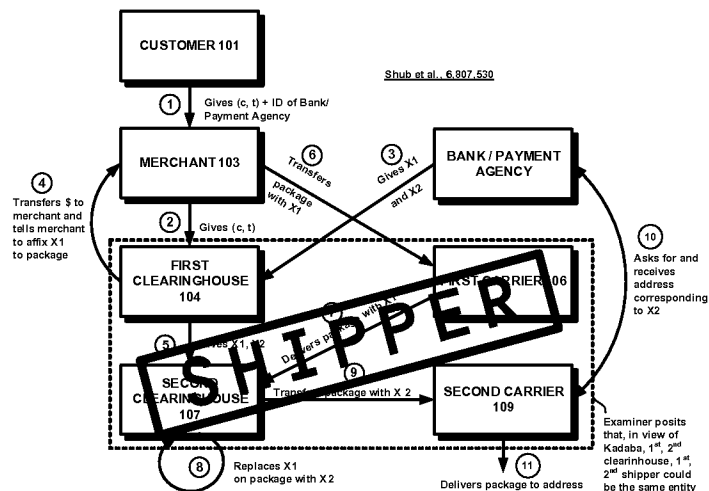
the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper

As will be demonstrated below, these claimed steps are not taught or suggested by the applied combination, nor are such steps taught or suggested indirectly through a series of intermediate steps that, in the aggregate, would be equivalent to the above steps.

The method taught by Shub et al. (the primary reference) looks like this:



The Office's position in the final Office Action that the first, second shippers and the first, second clearing houses could be aggregated into a single entity for the purposes of a §103(a) rejection is, respectfully, contrary to both established Court precedents and the Patent Office's own guidelines for the examination of patent applications. If, *arguendo*, the first, second shippers and the first, second clearing houses were to be aggregated into a single entity (a shipper, as urged by the Office and as allegedly taught by Kadaba), Shub et al.'s method would look like this:



In that case, all that is left is a configuration in which a single shipper picks up the goods directly from a merchant and delivers them to a delivery address. This, clearly, would render Shub et al.: a) arguably unsatisfactory for its intended purpose; and b) arguably impermissibly change its principle of operation. Indeed, one of the stated goals of Shub et al. is to prevent any single party (except the customer) from having complete information about a transaction. Indeed, if the first, second clearing houses and first, second carriers were to be combined as suggested by the Office and by, as urged by the Office, Kadaba, the single shipper would then have knowledge of both the customer and of the merchant, the identity of the customer's bank and the price (denoted by $s(M)$ in Shub et al.) paid by the customer for the goods. This, however, is explicitly contrary to the methods and apparatus of Shub et al.:

(57)

ABSTRACT

A method and apparatus which enables customers to remotely order goods from a merchant and receive the goods without revealing customer identity or address to the merchant, nor revealing what is bought to the bank or payment agency, and more generally to preserve as much anonymity as required such that no party except the customer has complete information about a transaction. The method uses clearing houses or encryption to break links between customer information and the merchant.

Indeed, if the first and second clearing houses and the first and second carriers of Shub et al. were to be aggregated into a single entity (i.e., United Parcel Service-UPS-as urged by the Office), then the shipper would know the merchant (from whom he shipper picked up the package), the customer's bank (from whom the single shipper would receive payment to be transferred to the merchant 103) and the customer (to whom the shipper delivers the package). However, such a scheme would be squarely against the explicit teachings of the primary reference to Shub et al., who tell us:

The protocol we describe is such that, except for the customer, no party (employee or company) ever possesses all the information necessary to link the customer to the merchant. The system is also such that some complicity of

Therefore, the Office's final rejection of the claims over the Shub et al.-Kadaba combination does, in fact, render the prior art: a) clearly unsatisfactory for its intended purpose; and b) certainly impermissibly change its principle of operation. The Office's interpretation of the applied combination is unsatisfactory for its intended purpose because such an aggregation of the first and second clearing houses and the first and second carriers no longer provides anonymous commercial transactions, as the "aggregated shipper" has knowledge of the merchant, the customer, the price paid for the goods by the customer and the customer's bank. For the Office to insist that anonymity is somehow preserved by using multiple clearing house facilities and multiple carriers or trucks within a single company (such as UPS as urged in the Final Office Action) is simply disingenuous—and is like claiming to not know how much money one has because some of it is in one pocket and the rest of the money is in another pocket. The Office's statement in the Advisory Action that "the Examiner cannot agree that the proposed combination renders Shub et al. unsatisfactory for its intended purpose or impermissibly changes its principles of operation" is ill considered. Of course the proposed combination changes the principle of operation of Shub et al. Shub et al. go to great lengths to segregate information by resorting to staged performances and multiple actors to anonymously deliver a package from a merchant to the customer, without any party being able to link the merchant to the customer. It is immediately apparent that if the first and second clearing houses 104, 107 and the first and second carriers 106, 109 were to be aggregated as in the proposed combination, the aggregated

entity would then have all of the information needed to link the merchant and the customer – and the bedrock principle of operation of Shub et al. (anonymity) would be compromised.

Shub et al., however, are not wholly inflexible and teach that some modifications are possible (see Col. 4, lines 10-14):

¹⁰ Clearly, if the customer **101** so desires, she/he can ask the merchant **103** to only use some simplified version of the protocol, in particular avoiding one of the clearing houses **104** and **107** whose role will be described below. The

Likewise, Shub et al. also teach that the first carrier and the merchant may be a single entity (see Col. 5, lines 25-29):

involved in the buy can be recognized, the merchant **103** transfers all packages **105** labeled with first bank order number x1 to the first carrier **106**; the merchant **103** may well be that carrier without compromising the anonymity of the customer.

The clearing houses could even belong to the same company (see Col. 5, lines 45-47):

a portion of s(TPH): notice that clearing houses **104** and **107** ⁴⁵ can belong to the same company without reducing the security of the system.

However, nowhere in Shub et al., is any teaching or suggestion to aggregate the first and second clearing houses 104, 107 with the first and second carriers 106, 109, as urged by the Office. Indeed, Shub et al. cannot arbitrarily be interpreted to teach only a single carrier that incorporates the first and second clearing houses. Kindly recall that two bank order numbers X1 and X2 are necessary in Shub et al. In fact, Shub et al. explicitly and most emphatically state that “An essential part of the invention is that a clearing house replaces X1 with X2. This breaks the link between the merchant and the company which delivers the goods to the customer” (see Col. 4, lines 57-61). This step is indeed essential, because it is the bank order number X2 that is used by the second carrier 109 to obtain the ultimate delivery address from the payment agency 102

(see step 10 above). The first carrier 106 delivers the package from the merchant 103 to the second clearing house 107 (see step 7 above) and the second carrier 109 delivers the package (this time, labeled with bank order number X2) from the second clearing house 107 to the address given to it by the bank/payment agency 102.

Such indirection (first and second clearing houses, first and second carriers) are necessary in Shub et al. to prevent any one party (other than the customer) from having complete knowledge of the transaction, a stated goal of this reference. To arbitrarily aggregate the clearing houses and the carriers would both render Shub et al. unsatisfactory for its intended purpose and would impermissibly change the principle of operation of Shub et al. Aggregating the first and second clearing houses 104, 107 with the first and second carriers 106, 109 would expressly contradict what the Shub et al. patentees have told is an “essential” (read, mandatory) part of the invention (how often does one encounter such unequivocal language in a patent?). The Examiner is not free to disregard such unequivocal teaching for the purpose of shoehorning the Shub et al. reference into an ill fitting combination to make a rejection under §103(a) rejection.

The Board’s attention is drawn to the guidance promulgated by the MPEP in cases such as these as well as to the authorities cited by the Patent Office in support of the promulgated guidance:

M.P.E.P. Section 2143.01, Suggestion or Motivation to Modify the References

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter

assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In *re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate. 270 F.2d at 813, 123 USPQ at 352.).

In the present case, it is respectfully submitted that aggregating the clearing houses and carriers into a single carrier would do both of these things. Therefore, it is respectfully submitted that the Office is not free to characterize the Shub et al. reference in a manner that would change its principle of operation (as a single carrier that would replace both the clearing houses and the carriers certainly would) and render it unsatisfactory to its intended purpose (namely, to prevent any one party from having complete knowledge of the customer’s transactions and to preserve the identity of the customer from the various players).

In the Advisory Action of July 12, 2007, the Examiner faults the above analysis relative to rendering the prior art unsatisfactory for its intended purpose and impermissibly changing the mode of operation of the prior art and distinguishes the cases cited in the MPEP by stating that

It should also be noted that Applicant's arguments against Shub are quite different from cases cited in support thereof. For example, it would not be obvious to turn a strainer for removing dirt and water from gasoline upside down because, by doing so, dirt and water would no longer be removed. On the other hand, the proposed modification to Shub still clearly results in the customer's package being delivered to the customer and, as shown above, certain information from the transaction is still protected.

It is respectfully submitted that the Examiner's arguments are in error. The Examiner's arguments appear to state that stripping the features that make Shub et al.'s system (entitled "Method And Apparatus For Remote Commerce With Customer Anonymity") anonymous is acceptable in the context of a §103(a) rejection, because the package still gets delivered to the customer. Anonymous commerce is the whole point of Shub et al.—not simply delivering a package to a customer. If anonymity is compromised by modifying Shub et al. in the manner outlined above, Shub et al., by definition, is rendered unsatisfactory for its intended purpose and the mode of operation thereof is changed, and impermissibly so, according to the Office's own guidelines.

The Shub et al.–Kadaba combination fails to teach or to suggest the claimed limitation of:

the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;

Indeed, in the applied combination, the bank does not receive such an electronic draft from either the customer 101 or from the merchant 103. In Shub et al., the bank/payment agency 102 is contacted by the first clearing house 104 and then transfers s(M), s(TPH) as well as X1 and X2 to the first clearing house 104. Never, in Shub et al. does the bank/payment agency 102

receive an electronic draft from the customer (or the merchant 103 on behalf of the customer) along with a request for a package code, as claimed and required by independent claim 1 and its dependent claims. Moreover, no reasonable interpretation of the Shub et al.–Kadaba combination would suggest that the bank receives any request from the customer 101 or the merchant 103, as such would break the anonymity of the merchant 103 vis-à-vis the bank/payment agency 102 that is foundational in Shub et al. (although the merchant 103 is aware of the identity of the customer’s bank 102 (**see step 1 above**)).

The Shub et al.–Kadaba combination also fails to teach or to suggest the claimed limitation of:

the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper

In Shub et al. the bank is provided with X2 by the second carrier (**see steps 9 and 10 above**), and receives the address corresponding to X2 from the bank/payment agency 102 in return. X1 and X2 and the “essential” step of replacing X1 with X2 must be carried out in Shub et al. It would make no sense, in the Shub et al. universe, for the second clearing house 109 to both request X2 from the bank, then request the address corresponding to X2 from the bank, and replace X1 with X2. In any event, Sub et al., even if a person of ordinary skill were in full possession of the Shub et al.–Kadaba combination, such a person would not be motivated to devise a method in which a bank sends a generated shipping identifier and a retrieved address to the shipper as claimed and required by independent claim 1—especially in view of the “essential” language of replacing a previously obtained X1 with a newly obtained X2, as mandated by Shub et al.

For the sake of completeness, note that Shub et al. do disclose an embodiment that uses encryption rather than clearing houses (**see Col. 5, beginning at line 64**). However, such methods involve the payment agency issuing a series of numbers for remote buys which the customer must give to an agent of the merchant upon making a purchase (see Col. 6, beginning at line 43) and receives an order number in exchange (**see Col. 6, lines 49-50**). A label that does not reveal the delivery address in the clear (it is accessible a secret encoding key in the possession of the carrier) may then be printed at the merchant's locale (**see Col. 6, lines 59 to Col. 7, line 2**). However, such does not teach or suggest the claimed embodiments, either alone or in combination with the secondary reference. For example, and for the reasons discussed above, the steps of claim 1 are not taught or suggested in this alternative embodiment or in the remainder of Shub et al.:

the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;

...

the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and

the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper

Lastly, Shub et al. disclose a last embodiment in the penultimate paragraph before the claims (**see Col. 7, lines 10-21**):

There are modifications possible to this invention, obvious to anyone skilled in the art. For example, the merchant 311 could simply print a label with the order number corresponding to the customer order 307 and attach it to the package and give it to the delivery agency 310. The delivery agency 310 could then contact the payment agency 303 with the order number and obtain a shipping address which can be printed and attached to the package. While the invention has been described in terms of a preferred embodiment and an alternate embodiment, those skilled in the art will recognize that the invention can be practiced with modification within the spirit and scope of the appended claims.

This modification teaches the following steps:

The merchant prints a label with an order number that corresponds to the customer order 307 (which presumably corresponds to one of the provided “series of numbers for remote buys”);

The merchant attaches the label to the package;

The merchant gives the labeled package to the delivery agency;

The delivery agency contacts the payment agency, gives it the order number on the label and obtains therefrom the shipping address of the package.

However, wholly unsuggested by this last modification proposed by Shub et al. would be the claimed steps:

the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;

...

the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer’s account, and

the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper

For example, such a modification does not teach or suggest any step of the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper, as claimed in claim 1.

Indeed, Shub et al. teaches that the bank/payment agency 102 does two things: the bank/payment agency 102 sends X1 and X2 to the first clearing house (**see step 3 above**) and the bank/payment agency sends the second carrier 109 the address corresponding to X2 (which was previously provided to the second carrier 109 by the second clearing house 107). The Shub et al.–

Kadaba combination (whether modified as urged by the Office or not), therefore, cannot be said to teach any step of the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper, as required by claim 1.

In view of the above, reversal of the 35 U.S.C. §103(a) rejections of claim 1 and of its dependent claims are believed to be warranted. The same, therefore, is respectfully requested.

Independent Claim 7

Shub et al. discloses that the merchant 103 and the first carrier 106 can be one and the same (see Col. 5, lines 27-29) and that the first and second clearing houses 104, 107 can belong to the same company without reducing the security of the system (see Col. 5, lines 45-47). Shub et al., however, never disclose that the first and second clearing houses 104, 107 and the first and second carriers 106, 109 can belong to the same company (as suggested by Kadaba, according to the Office), as such would impermissibly change the principle of operation of Shub, for the reasons advanced above. Moreover, even if Shub et al. were to be modified as urged by the Examiner, such a combination would still fail to teach or to suggest the steps recited in independent claim 7:

the shipper receiving a request to pick up a package from the vendor, the package having a machine-readable package code affixed thereto but no delivery address;

the shipper receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank at which the customer having purchased the goods contained in the package maintains an account, the delivery address being associated with the customer's account at the bank;

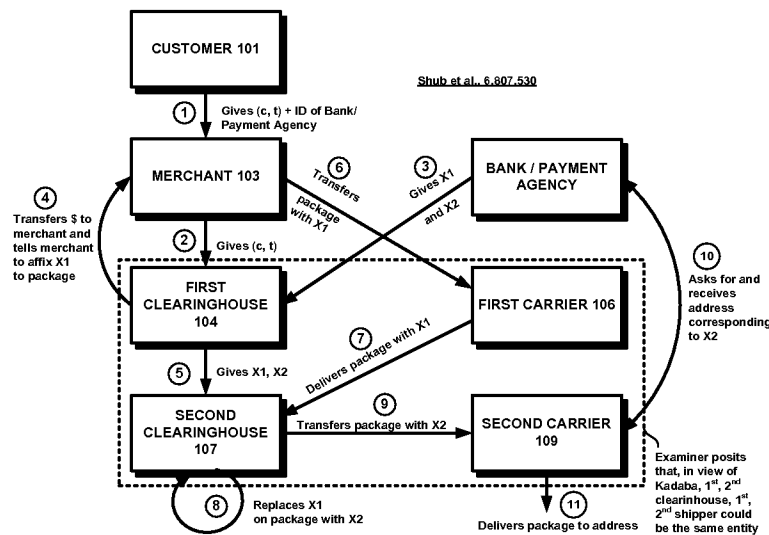
the shipper picking up the package from the vendor;

the shipper reading the package code affixed to the package;

the shipper matching the package code with the received shipping identifier, and

the shipper delivering the package from the vendor directly to the delivery address associated with the shipping identifier.

For example, the proposed combination (even if such were a proper combination, which it is not) does not teach or suggest any of the first or second carriers (individually or collectively) receiving a shipping identifier and a delivery address from a bank, as required by claim 7 and its dependent claims. Shub et al. do teach a payment agency 102, but this payment agency 102 is nowhere taught or suggested to send a shipping identifier and a delivery address associated with the shipping identifier to the first carrier 106 or the second carrier 109. Indeed, as shown hereunder, Shub et al.'s system



teaches that the carrier 106 receives the package and X1 from the merchant 103 (see step 6 above), teaches that the first carrier 106 delivers the package to the second clearing house 107 along with X1 (see step 7 above), teaches that the second carrier 109 receives the package from the second clearing house along with X2, and teaches that the second carrier 109 requests and receives the delivery address that corresponds to X2 from the payment agency or bank 102. Neither the first nor the second carrier 106, 109, whether considered alone or collectively, are taught or suggested by Shub et al. (or by the Shub et al.–Kadaba combination) to receive

a shipping identifier and a delivery address associated with the shipping identifier from a bank

as claimed in and required by independent claim 7. Indeed, in Shub et al., the carrier 106 and/or 109 does not receive a shipping identifier from any bank. Instead, Sub et al. teach that X1 is provided to the first carrier 106 by the merchant 103 and that X2 is provided to the second carrier 109 by the second clearing house 107. Even if the first and second clearing houses 104, 107 and the first and second carriers 106, 109 were to be combined into a single carrier (such as, for example, UPS as taught by Kadaba) as urged by the Examiner, the proposed combination would still not teach or suggest a carrier receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank, as required by independent claim 7. Therefore, even if the proposed combination of references were proper and/or in accordance with USPTO guidelines and court precedents (which it is not), the applied combination would still fail to teach or to suggest the claimed limitations.

The architecture of Shub et al.'s method appears to be designed to isolate the bank from the merchant (i.e., the bank/payment agency 102 does not know the identity of the merchant 103—although the reverse is not true) and to isolate the second carrier 109 (the one which ultimately delivers the package in Shub et al.) from the merchant 103 (as the second carrier 109 only receives the package with X2 from the second clearing house 107). Therefore, to modify the Shub et al.—Kadaba such that the shipper receives a shipping identifier and a delivery address associated with the shipping identifier from a bank, as claimed, would be contrary to the teachings, suggestions and intended purpose of Shub et al., whether considered alone or in combination with Kadaba and whether modified as urged by the Examiner or not. Such a modification would not occur to a person of ordinary skill in the art, as Shub et al. expressly teaches away from the claimed steps and

the Examiner's interpretation of the applied combination. Therefore, the §103(a) rejections applied to independent claim 7 and its dependent claims are in error and should be reversed.

Independent Claim 13

Claim 13, written from the point of view of the merchant, also recites steps that are not taught or suggested by Shub et al.-Kadaba, such as:

the vendor receiving payment on the draft and the package code from the bank only if the customer is authenticated by the bank and bank-imposed constraints are satisfied, the package code being devoid of delivery address information;

In Shub et al., the merchant 103 does not receive anything from the customer's payment agency (bank) 102—as shown clearly in the diagram above. Instead, Shub et al. (whether considered singly or in combination with Kadaba) teaches that it is the first clearing house 104 that transfers s(M)-the price of the merchandise to the merchant 103-and not the payment agency 102 (**see Col. 5, lines 11-20**):

After terminating the dialog with payment agency 102, first clearing house 104 tells merchant 103 that the transaction can be honored, and transfer s(M) and some part of s(TPH) to merchant 103: the details of how each party gets paid need not be universal and will not be discussed. First clearing house 104 also tells merchant 103 the first bank order number x1, which merchant 103 will then attach to each package related to the transaction. Merchant 103 then lets first clearing house 104 know how to contact second clearing house 107.

Moreover, the payment agency/bank 102 of Shub et al. is nowhere taught or suggested to transfer any package code to the merchant, as required by claim 13 and its dependent claims. Instead, Shub et al. teach that it is the first clearing house 104 (having previously received X1 and X2 from the payment agency 102) that transfers the payment for the goods s(M) and X1 to the merchant, so that the merchant 103 may affix X1 to the package. Therefore, even if the proposed

combination of Shub et al. and Kadaba were proper and modifiable as urged by the Examiner (which, respectfully, it is not), the applied combination does not teach or suggest the claimed limitations.

It is worthy of note that, in Shub et al. (and in direct contradistinction with the claimed embodiments), the bank/payment agency 102 does not send anything to the merchant 103: the sequence of a “buy” transaction is outlined in Shub et al. (see Col. 4, lines 26-38):

To perform a buy, the customer 101 contacts the merchant 103 and, when placing an order, gives the merchant 103 the pair of numbers (c, t) and the identity of the payment agency 102. It is usually considered that the Internet will be used to protect the anonymity of the customer 101, but machines with which customer 101 has no formal recognizable link may also be used, such as a public telephone, a letter, etc. We write S for the cost of the total transaction, including merchandise M and transport, packing and handling (in short TPH). So S is the sum of the price s(M) of the merchandise and of the price s(TPH) of TPH. The portion s(TPH) will depend on options offered to the customer such as extra repackaging by the second clearing house or reduced protocol.

The merchant 103 then contacts the first clearing house at 104. Merchant 103 tells first clearing house 104 the pair (c, t), the name of payment agency 102, and the amount S.

After making itself recognized as a participating clearing house (i.e. part of an ACP), first clearing house 104 confirms with payment agency 102 that the funds for the transaction are available. Then first clearing house 104 receives s(M) and the part of s(TPH) not due to the second carrier described later, and possibly some extra transaction cost, from payment agency 102. Payment agency 102 also tells first clearing house 104 a pair of bank order numbers x1 and x2 (although payment agency 102 is not necessarily a bank). Note that this first clearing house can be a purely electronic clearing house, i.e. it could be just a computer handling transactions and order numbers, etc.

Therefore, Shub et al. teach that the first clearing house 104 receives at least s(M) from the bank/payment agency 102 and it is the first clearing house 104 that transfers payment to the merchant, and not the bank as required by independent claim 13 and its dependent claims. Therefore, not only does the applied combination fail to teach the claimed subject matter, but the applied combination actually teaches away from the claimed method in which the vendor receives

payment on the draft from the bank as well as the claimed package code. Again, Shub et al. expressly teaches that the bank/payment agency has no contact with the merchant 103 and certainly does not send any package code (as claimed) to the merchant (even if the first and second clearing houses and carriers were to be aggregated, as impermissibly urged by the Examiner). No suggestion could be gleaned from the applied combination that would lead a person of ordinary skill in the art to modify Shub et al., Kadaba or the combination of the two to modify Shub et al. in such a manner that the merchant would receives payment on the draft from the bank as well as the claimed package code, as such would vitiate the existence and very purpose of Shub et al.'s first clearing house 104.

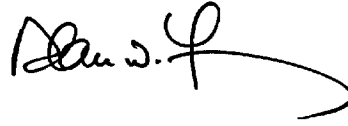
Therefore, the §103(a) rejections applied to independent claim 13 and its dependent claims are in error and should be reversed.

The dependent claims incorporate, by definition, the subject matter of their respective independent claims. As such, the arguments presented above relative to the independent claims are equally applicable to their dependent claims and the dependent claims stand or fall with their respective independent claims.

Each independent claim defines methods and specifically-identified steps that are not shown or suggested, either directly or indirectly, by the applied combination of references. Moreover, the applied combination of references is believed to be improper in view of the Patent Office's own guidelines and relevant court precedents, developed fully above. In view thereof, it is respectfully submitted that the 35 U.S.C. §103(a) rejection applied to the claims should be reconsidered and reversed. The same is, therefore, respectfully requested. Appellant respectfully requests a reversal of the rejections and a finding that the pending claims are allowable.

An oral hearing is not requested.

Respectfully submitted,



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By: _____

Alan W. Young
Attorney for Applicants
Registration No. 37,970

YOUNG LAW FIRM, P.C.
4370 Alpine Rd., Ste. 106
Portola Valley, CA 94028
Tel.: (650) 851-7210
Fax: (650) 851-7232

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H. Claims Appendix

1. **(Previously Presented)** A method for a bank to enable anonymous shipment by a shipper of a package containing goods purchased by a customer from a vendor for delivery to an address unknown to the vendor, the customer maintaining an account at the bank, the bank storing an address associated with the customer's account, the method comprising the steps of:

the bank receiving an electronic draft from the customer for the purchase of the goods along with a request for a package code for the package;

the bank authenticating the customer and guaranteeing payment to the vendor on the draft only if the customer is authenticated and bank-imposed restrictions are met;

if the customer is authenticated and bank-imposed restrictions are met,

the bank generating the requested package code, the package code being devoid of delivery address information;

the bank sending the generated package code to the vendor, wherein the bank does not send any delivery address information for the package to the vendor; and

the bank generating a shipping identifier for the package that is associated with the generated package code and retrieving the stored address associated with the customer's account, and

the bank sending the generated shipping identifier and the retrieved address associated with the customer's account at the bank to the shipper to enable the shipper, after picking up the package for shipment from the vendor, to associate the package code sent to the vendor with the shipping identifier, to identify the associated address as the delivery address of

the package, and to ship the package directly from the vendor to the delivery address without divulging any delivery address for the package to the vendor.

2. **(Original)** The method of claim 1, wherein the package code includes at least one of a code number and machine-readable indicia expressing the code number.

3. **(Original)** The method of claim 1, wherein the received request includes at least one of a request for authentication and an electronic draft for payment of at least one of the purchased goods and a shipping charge.

4. **(Original)** The method of claim 1, wherein the receiving and sending steps are performed over a computer network.

5-6. **(Canceled)**

7. **(Previously Presented)** A method for a shipper to process a package identified by a package code devoid of delivery address information, the package containing goods purchased by a customer from a vendor for shipment to an address unknown to the vendor, the method comprising the sequential steps of:

the shipper receiving a request to pick up a package from the vendor, the package having a machine-readable package code affixed thereto but no delivery address;

the shipper receiving a shipping identifier and a delivery address associated with the shipping identifier from a bank at which the customer having purchased the goods contained in the package maintains an account, the delivery address being associated with the customer's account at the bank;

the shipper picking up the package from the vendor;

the shipper reading the package code affixed to the package;
the shipper matching the package code with the received shipping identifier, and
the shipper delivering the package from the vendor directly to the delivery address associated with the shipping identifier.

8. **(Original)** The method of claim 7, further comprising the steps of printing a shipping label on which the delivery address is visible and affixing the shipping label on the package.

9. **(Original)** The method of claim 7, wherein the package code includes at least one of a code number and machine-readable indicia expressing the code number.

10. **(Original)** The method of claim 7, wherein the receiving step is performed over a computer network.

11-12. **(Canceled)**

13. **(Previously Presented)** A method for a vendor to cause a package of goods purchased by a customer to be delivered to a delivery address that is unknown to the vendor, the method comprising the steps of:

the vendor sending a request for a package code to a bank at which the customer maintains an account and an electronic draft for payment of the goods on behalf of the customer;

the vendor receiving payment on the draft and the package code from the bank only if the customer is authenticated by the bank and bank-imposed constraints are satisfied, the package code being devoid of delivery address information;

the vendor preparing the package for shipment by the shipper such that the prepared package bears no delivery address information thereon;

the vendor affixing the received package code to the prepared package, and

the vendor surrendering the package to a shipper to enable the shipper to match the package code with a shipping identifier and the delivery address that were previously received by the shipper from the bank, to generate a shipping label specifying the delivery address, to affix the shipping label to the package and to ship the package directly from the vendor to the delivery address without divulging any delivery address to the vendor.

14. **(Original)** The method of Claim 13, wherein the package code includes at least one of a code number and machine-readable indicia expressing the code number.

15. **(Original)** The method of Claim 13, wherein the request includes at least one of a request for authentication and an electronic draft for payment of at least one of the purchased goods and a shipping charge.

16. **(Original)** The method of Claim 13, wherein the receiving and sending steps are performed over a computer network.

17-28. **(Canceled)**

I. Evidence Appendix

None.

J. Related Proceedings Appendix

None.